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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/427,447 10/27/99 SZYNALSKI

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EXAMINER
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TM02/0626

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RIMELL, S	
ART UNIT	PAPER NUMBER

2166

DATE MAILED:

06/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/427,447

Applicant(s)

SZYNALSKI, ALEXANDER  
GOEN

Examiner

Sam Rimell

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_

SAM RIMELL  
MURRAY STANLEY  
AS 2/66

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5, 7-10, 12-15 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 2-5, 7-10, 12-15 and 17-20 set forth a number of different substances which are described applicant as either being intended for smoking cessation or weight loss. The disclosure does not set forth the therapeutically effective amounts for any of the substances set forth in these claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by admitted prior art to Vitamerica Inc .

Applicant's disclosure admits (page 5, para 4) that lobeline is utilized in a known prior art ingestible product known as "Cigsation". Applicant's disclosure (page 26, para 2) admits that all the remaining claimed substances are contained in a known prior art ingestible product called "Trim Specifics". Applicant's disclosure further admits (page 11, para 4) that the hypnosis and

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education steps are contained in a known prior art tape program called "Smoking Cessation". All of these products are available from a common source, known as Vitamerica Inc., and are available on the internet at [www.vitamerica.com](http://www.vitamerica.com). Since each of these products derives from a common source, it is reasonable to presume that they are intended to be used together in a method for addressing a smoking addiction.

Applicant submits an affidavit under 37 CFR 1.131 to "swear behind" this reference. However, this affidavit does not make any discussion of the activity of the present inventor, and thus cannot be effective in "swearing behind" the admitted prior art.

The affidavit does establish that the products sold by Vitamerica, Inc. were in fact offered for sale to the public prior to the filing date of the present invention, and thus qualify as prior art under 35 USC 102(a).

#### Remarks

With respect to the rejection of claims under 35 USC 112, 1<sup>st</sup> paragraph, applicant's arguments are only well taken as they pertain to claims 1 and 11. The prior art reference to Schneider does establish a therapeutically effective amount of Lobelia. However, no other information establishes the therapeutically effective amounts for any of the other substances claimed. Thus, the disclosure is non-enabling for claims 2-5, 7-10, 12-15 and 17-20.

The rejection of claims 1-20 under 35 USC 101 has been withdrawn.

The rejection of claims 1-20 under 35 USC 102 has been sustained. An affidavit under 37 CFR 1.131 which does not discuss applicant's own activity cannot be effective in swearing behind a prior art reference.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
Art Unit 3712